

### **REMARKS**

Claims 1-35 and 108-111 were pending in this application when the present Office Action was mailed (April 6, 2004). Claim 1 has been amended and claims 112-123 have been added. Of the added claims, claims 112-121 correspond to dependent claims written to be in independent form. Accordingly, any subsequent rejection of these claims on new grounds should not be made final.

In the Office Action mailed April 6, 2004, claims 25-35 and 108-111 were allowed and the remaining claims were either rejected or objected to. More specifically, the status of the application in light of this Office Action is as follows:

(A) Claims 1, 6, 11-15, 17 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,993,637 to Hisamatsu et al. ("Hisamatsu"); and

(B) Claims 25-35 and 108-111 stand allowed, with claims 2-5, 7-10, 16, 18, 19 and 21-24 objected to, but indicated to be allowable if rewritten to be in independent form.

The undersigned attorney wishes to thank the Examiner for engaging in a telephone interview on July 1, 2004. During the interview, the pending claims and applied reference were discussed, and the Examiner indicated that claim 1 would be allowed if amended to clarify that the method identified by the claim does not require direct electrical contact between first and second electrode and a microelectronic substrate to remove conductive material from the substrate. Claim 1 has been amended in accordance with this agreement. The following remarks reflect the above agreement and summarize the substance of the July 1, 2004 telephone interview.

A. **Response to the Section 102 Rejections**

Claims 1, 6, 11-15, 17 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hisamatsu. As discussed during the July 1 telephone conference, Hisamatsu discloses an arrangement for removing material from a wafer by connecting one side of a power supply directly to a wafer and connecting the other side of the power supply to a first electrode that communicates with the wafer via an electrolytic

solution. A pair of second electrodes have a polarity identical to that of the wafer so as to function as an auxiliary electrode. Accordingly, the second electrodes are electrically connected to the wafer (see Figure 2 of Hisamatsu). By contrast, claim 1 specifically includes removing material from a microelectronic substrate with first and second electrodes spaced apart from the conductive material of the microelectronic substrates and "while the first electrode and the second electrode are electrically connected to the microelectronic substrate only via the electrolyte." Therefore, Hisamatsu fails to disclose or suggest at least this feature of claim 1 and the Section 102 rejection of claim 1 should be withdrawn.

Claims 6, 11-15, 17 and 20 all depend from claim 1. Accordingly, the Section 102 rejections of these claims should be withdrawn for at least the foregoing reasons, and for the additional features of these dependent claims.

B. Response to the Indication of Allowable Subject Matter

Claims 25-35 and 108-111 were allowed and have not been amended herein. Claims 2, 3, 5, 7, 8, 9, 16, 18, 22, and 23 were indicated to be allowable if rewritten to be in independent form. These claims have been rewritten as claims 112-121. Accordingly, claims 112-121 are in condition for allowance.

New claims 122 and 123 include many of the features of claim 1. New claim 122 includes removing at least part of the conductive material from the microelectronic substrate by passing a varying current from at least one of the first and second electrodes through the electrolyte to the microelectronic substrate without passing the varying current through an electrical connection attached directly to the microelectronic substrate. New claim 123 includes removing at least part of the conductive material while the first and second electrodes are at different electrical potentials than the microelectronic substrate. Hisamatsu fails to disclose or suggest, *inter alia*, either of these features. Accordingly, these claims are in condition for allowance.

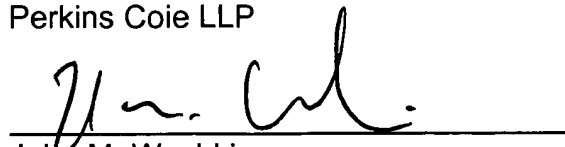
C. Conclusion

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of

Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3257.

Respectfully submitted,

Perkins Coie LLP



John M. Wechkin

Registration No. 42,216

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**Correspondence Address:**

Customer No. 25096

Perkins Coie LLP

P.O. Box 1247

Seattle, Washington 98111-1247

(206) 359-8000